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64
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,490	07/27/2001	Hung-Ju Lee	SNY-P4516	9213

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MILLER PATENT SERVICES
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RALEIGH, NC 27606

EXAMINER

AN, SHAWN S

ART UNIT	PAPER NUMBER
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2613

DATE MAILED: 01/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/916,490	LEE, HUNG-JU	
	Examiner	Art Unit	
	Shawn S An	2613	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's submission of 37 C.F.R. 1.131 as filed on 8/16/04 has been acknowledged.

Response to Remarks

2. Applicant's rebuttal with respect to all of the original claims based on a declaration under 37 CFR 1.131 has been considered.

However, since the Examiner has the extra burden of searching all of the original claims again, due to the Applicant's declaration under 37 CFR 1.131, the Examiner has carefully examined all of the original claims, and observed that the claims does contain claims directed to the following patentably distinct species of the claimed invention as previously discussed in the last office action as filed on 6/7/04.

The Examiner initially agreed on Applicant's response with the exception of claim 16 to the election/restriction requirement, based on relevancy of the claims, and being able to find the Vetro reference within a reasonable amount of time, which happened to comprise of numerous teachings incorporating substantially all of the independent claims. Therefore, the Examiner initially examined all of the claims with the exception of claim 16.

Now, it seems that Vetro's reference can no longer be relied on based on the Applicant's declaration under 37 CFR 1.131.

Furthermore, the Examiner has found following claim groups do fall under patentably distinct species of the claimed invention.

Species I: Claims 1-3, 4-9, and 29-31 (An apparatus/method computing/having drift compensation);

Species II: Claims 10-15 and 32 (A software/method for reducing drift in a block);

Species III: Claims 17-22 and 23-28 (An apparatus/method of drift compensation that compensates a current frame having a motion vector associated therewith);

Species IV: Claim 16 (An MPEG transcoder).

The Examiner agrees with the fact that all of the claims corresponding to the above species are somewhat related. However, the Examination (second time) of all of the claims does indeed create undue burden on the Examiner by virtue of searching the four distinct (independent) species corresponding to claims 1-32 as discussed above.

The prior art searching and a prosecution clearly would be a burden based on the four distinct species. A reasonable search for one species does not necessarily cover other species corresponding to other claims/figures.

Therefore, the Examiner's election/restriction follows.

Election/Restrictions

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Fig. 1 (block diagram of a drift reduction arrangement in an MPEG transcoder)

Species II: Fig. 2 (generation of a drift reference frame)

Species III: Fig. 3 (mapping the drift reference block to a block to be compensated)

Species IV: Fig. 4 (drift compensation)

Species V: Fig. 5 (flow chart, creation of a drift reference frame)

Species VI: Fig. 6 (flow chart, compensation for drift using the drift compensation frame created in process 500 of Fig. 5)

Applicant is required under 35 U.S.C. 121 to elect a **single** disclosed **species** on the basis of the corresponding figures listed above, and to indicate to the Examiner which of the claims 1-32 read on the elected figure of the disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is considered generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to **Shawn S An** whose telephone number is 703-305-0099. The Examiner can normally be reached on Flex hours (10).

Art Unit: 2613

5. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SSA

Primary Patent Examiner

12/28/04